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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/673,431
Filing Date: September 30, 2003
Appellant(s): KOBEH ET AL.

Robert L. Hails
For Appellant

EXAMINER'S ANSWER

This is in response to the Appeal Brief filed December 29, 2008, appealing from the Office action mailed August 1, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The Appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The Appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2005/0192826	Kanefsky	11-2005
2002/0120538	Corrie et al.	8-2002

7,111,010

Chen et al.

9-2006

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-10, 13-18, 20, & 22-27** are rejected under 35 U.S.C. 103(a) as being unpatentable over Corrie et al. (U.S. 2002/0120538), and further in view of Kanefsky (U.S. 2005/0192826).

As per claim 1, Corrie et al. teaches a computer-implemented grant management method (See figures 1 & 2B, which illustrates architecture for a grants management system), comprising:

if so determining, based on a set of rules derived from administrative and financial requirements of the plurality of grants encoded in a database (See paragraphs 70 & 111, which discusses decision rules developed by the granting agency), if the converted data causes a limit defined under the one of plurality of grants to be exceeded (See paragraphs 155 & 164, which discusses how funds are obligated based on agreement accounting rules, and how a determination is dynamically made by the financial management system whether limits are exceeded), and

if not, admitting the requested transaction, (See paragraph 156, which discusses approving a request from a grantee),

otherwise, rejecting the requested transaction (See paragraph 148, which discusses rejecting an application if it does not meet the basic criteria and compliance requirements).

However, Corrie et al. does not expressly disclose:

a computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors;

responsive to a transaction request and data associated therewith, converting values of the associated data from a domain of a transaction system to a domain defined for one of the plurality of grants; and

determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid.

Kanefsky discloses a method and system for managing and reporting grants (See abstract)

Both Corrie et al. and Kanefsky discloses methods and systems for managing grants. Kanefsky discloses managing numerous grants received from a plurality of grantors (See figure 1 and paragraph 21, which illustrates and discusses a grant management and reporting system incorporating a plurality of grants and grantors) and determining if received or imported grant or financial information falls within a specified grant (See paragraph 33, which discusses receiving/importing grant and financial information and establishing detailed records pertinent to a specific grant). Therefore, it

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would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include converting received/imported grant and financial information to detailed records of a specified grant and incorporating automated management of multiple grants received by a recipient as taught by Kanefsky in order to provide data in a format that can be automatically uploaded, report the results of grant activities to multiple grantors, and to allow grantors to monitor the activities of grantees in real time (See paragraphs 7, 9, & 11, which discusses reporting grant activities to various administrative agencies, allowing the grantor to monitor the activities of a grantee in real time, and providing data in a format that can be automatically uploaded).

As per claim 2, Corrie et al. teaches wherein the domain of the transaction system and the domain of one of the plurality of grants are different (See figure 1 and paragraph 55, which illustrates and discusses a separate financial management server and grant management server).

As per claim 3, Corrie et al. teaches wherein the domain of the transaction system is the same as the domain of the one of the plurality of grants (See figure 1, which illustrates a financial management server and grant management server operatively connected in the same system).

As per claim 4, Corrie et al. teaches storing the transaction data in a database in the domain defined for the one of the plurality of grants (See paragraph 44, which discusses how the grant management system includes permanent or removable storage on which the process and data structures can be stored and distributed).

As per claim 5, Corrie et al. teaches determining if a report and/or a bill are due according to a predetermined set of report and billing rules (See paragraphs 77 & 161, which discusses status reports; and, furthermore, how the system receives financial reports and verifies award compliance);

retrieving transactional data stored in the domain defined for the one of the plurality of grants (See paragraph 160, which discusses accessing information from the grant management system); and

if the report and/or the bill are determined to be due, generating the report and/or the bill in the domain defined for the one of the plurality of grants (See paragraphs 77 & 161, which discusses status reports; and, how the system receives financial reports and verifies award compliance).

As per claim 6, Corrie et al. teaches an enterprise management system, comprising:

a transaction management system (See figure 1, which illustrates a financial management system), operating under a predetermined set of transaction rules and responsive to a transaction request by validating and accepting the transaction (See paragraphs 129 & 163, which discusses approving payment requests and accepting grant financial reports);

a grants management system provided in communication with the transaction system (See figure 1, which illustrates a grants management system operatively connected with a financial management system) and comprising:

an availability control unit to determine, based on a set of rules derived from administrative and financial requirements of the plurality of grants and encoded in a database (See paragraphs 70 & 111, which discusses decision rules developed by the granting agency), if the converted data would cause a limit defined under the grant to be exceeded (See paragraphs 155 & 164, which discusses how funds are obligated based on agreement accounting rules, and how a determination is dynamically made by the financial management system whether limits are exceeded); and

a database storing converted transaction of the transaction requests that map to valid classifications that do not exceed the defined limits (See paragraph 44, which discusses how the grant management system includes permanent or removable storage on which the process and data structures can be stored and distributed).

However, Corrie et al. does not expressly disclose:

An enterprise management system for managing a plurality of grants for a recipient received from a plurality of grant sponsors;

an interpretation logic unit to covert values of the transaction request from a domain of the transaction system to a domain defined for a grant identified from the plurality of grants; and

a dimensional control unit to determine if the converted data maps to a classification that has been defined under the grant to be valid.

Kanefsky discloses managing numerous grants received from a plurality of grantors (See figure 1 and paragraph 21, which illustrates and discusses a grant management and reporting system incorporating a plurality of grants and grantors) and

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determining if received or imported grant or financial information falls within a specified grant (See paragraph 33, which discusses receiving/importing grant and financial information and establishing detailed records pertinent to a specific grant). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include converting received/imported grant and financial information to detailed records of a specified grant and incorporating automated management of multiple grants received by a recipient as taught by Kanefsky in order to provide data in a format that can be automatically uploaded, report the results of grant activities to multiple grantors, and to allow grantors to monitor the activities of grantees in real time (See paragraphs 7, 9, & 11, which discusses reporting grant activities to various administrative agencies, allowing the grantor to monitor the activities of a grantee in real time, and providing data in a format that can be automatically uploaded).

Claim 7 recites equivalent limitations to claim 4 and is therefore rejected using the same art and rationale set forth above.

As per claim 8, Corrie et al. teaches a reporting and billing manager to generate a report and/or a bill when the report is due according to a predetermined set of reporting and billing rules (See paragraphs 77 & 161, which discusses status reports; and, furthermore, how the system receives financial reports and verifies award compliance).

As per claim 9, Corrie et al. teaches wherein the reports and bills are generated in the domain defined for the identified grant (See paragraphs 77 & 161, which

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discusses status reports; and, how the system receives financial reports and verifies award compliance).

As per claim 10, Corrie et al. teaches an enterprise management system, comprising:

a transaction management system (See figure 1, which illustrates a financial management system), operating under a predetermined set of transaction rules and responsive to a transaction request by validating and accepting the transaction (See paragraphs 129 & 163, which discusses approving payment requests and accepting grant financial reports);

a grants management system provided in communication with the transaction management system (See figure 1, which illustrates a grants management system operatively connected with a financial management system) and responsive to the transaction request by:

if so, determining, based on a set of rules derived from administrative and financial requirements of the plurality of grants encoded in a database (See paragraphs 70 & 111, which discusses decision rules developed by the granting agency), if the converted data would cause a limit defined under the grant to be exceeded (See paragraphs 155 & 164, which discusses how funds are obligated based on agreement accounting rules, and how a determination is dynamically made by the financial management system whether limits are exceeded); and

causing the transaction system to reject the requested transaction if the limit is exceeded (See paragraphs 152 & 164, which discusses rejecting a grant; and,

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furthermore, adjusting commitments and obligations based on drawdowns and accruals; additionally it is inherent to reject funds based on not satisfying account rules).

However, Corrie et al. does not expressly disclose:

an enterprise management system for managing a plurality of grants for a recipient received from a plurality of grant sponsors;

converting values of the transaction request from a domain of the transaction system to a domain defined for a grant identified from the plurality of grants; and

determining if the converted data maps to a classification that has been defined under the grant to be valid.

Kanefsky discloses managing numerous grants received from a plurality of grantors (See figure 1 and paragraph 21, which illustrates and discusses a grant management and reporting system incorporating a plurality of grants and grantors) and determining if received or imported grant or financial information falls within a specified grant (See paragraph 33, which discusses receiving/importing grant and financial information and establishing detailed records pertinent to a specific grant). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include converting received/imported grant and financial information to detailed records of a specified grant and incorporating automated management of multiple grants received by a recipient as taught by Kanefsky in order to provide data in a format that can be automatically uploaded, report the results of grant activities to multiple grantors, and to allow grantors to monitor the activities of grantees in real time (See paragraphs 7, 9, & 11, which discusses reporting grant activities to

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various administrative agencies, allowing the grantor to monitor the activities of a grantee in real time, and providing data in a format that can be automatically uploaded).

As per claim 13, Corrie et al. teaches a computer-implemented method for managing grants received from a sponsor (See figures 1 & 2B, which illustrates architecture for a grants management system), comprising:

receiving a transaction request and data associated with the transaction request from a transaction management system of a grant recipient (See paragraph 160, which discusses accessing information from the grant management system);

determining, based on a set of rules derived from administrative and financial requirements of the plurality of grants and encoded in a database (See paragraphs 70 & 111, which discusses decision rules developed by the granting agency), if the transaction request satisfies the rules imposed by the sponsor (See paragraphs 77 & 161, which discusses status reports; and, how the system receives financial reports and verifies award compliance);

if so, admitting the transaction request (See paragraph 129, which discusses approving payment requests);

otherwise, rejecting the transaction request (See paragraph 148, which discusses rejecting an application if it does not meet the basic criteria and compliance requirements).

However, Corrie et al. does not expressly disclose:

a computer-implemented method for managing a plurality of grants for a recipient received from a plurality of grant sponsors.

Kanefsky discloses managing numerous grants received from a plurality of grantors (See figure 1 and paragraph 21, which illustrates and discusses a grant management and reporting system incorporating a plurality of grants and grantors). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include automated management of multiple grants received by a recipient as taught by Kanefsky in order to report the results of grant activities to multiple grantors and to allow grantors to monitor the activities of grantees in real time (See paragraphs 7 & 9, which discusses reporting grant activities to various administrative agencies and allowing the grantor to monitor the activities of a grantee in real time).

As per claim 14, Corrie et al. teaches converting the associated data to a predetermined domain of a grant identified from the plurality of grants (See paragraphs 56 & 60, which discusses the interaction between a grants management system and a financial management system, including the use of EAI to process a request of a grant's financial activities).

As per claim 15, Corrie et al. teaches determining if the associated data maps to a valid budget entry for a grant (See paragraphs 60 & 61, which discusses mapping one system to a defined data schema and sending/receiving messages from one system to another thereby permitting integration; and, furthermore how the EAI tool component triggers updates to the financial system whenever any activity in the grants system has financial significance).

As per claim 16, Corrie et al. teaches rejecting the transaction request if the associated data maps to an invalid budget entry for the grant (See paragraphs 155 & 164, which discusses how funds are obligated based on agreement accounting rules, and how a determination is dynamically made by the financial management system whether limits are exceeded).

As per claim 17, Corrie et al. teaches determining if the associated data is consistent with a budgetary plan (See paragraph 129, which discusses approving payment requests; additionally it is inherent that payment request won't be approved unless it satisfies accounting rules).

As per claim 18, Corrie et al. teaches rejecting the transaction request if the associated data is inconsistent with the budgetary plan (See paragraphs 155 & 164, which discusses how funds are obligated based on agreement accounting rules, and how a determination is dynamically made by the financial management system whether limits are exceeded).

Claim 20 recites equivalent limitations to claim 5 and is therefore rejected using the same art and rationale set forth above.

As per claim 22, Corrie et al. teaches using a blocking indicator to indicate whether a report and/or a bill are due (See paragraphs 124-126, which discusses how grant managers and financial managers (i.e. manual operators) must clear requests before they are approved).

As per claim 23, Corrie et al. teaches an enterprise management system, comprising:

a transaction management system (See figure 1, which illustrates a financial management system), operating under a predetermined set of transaction rules imposed by a sponsor the grantee and responsive to a transaction request by validating and accepting the transaction (See paragraphs 129 & 163, which discusses approving payment requests and accepting grant financial reports); and

a grants management system of the grantee provided in communication with the transaction system (See figure 1, which illustrates a grants management system operatively connected with a financial management system), to determine if the transaction request satisfies the predetermined set of transaction rules imposed by the sponsor, and if so, storing transaction data, (See paragraphs 77, 160, & 161 which discusses accessing information from the grant management system, status reports, and how the system receives financial reports and verifies award compliance) wherein the grants management system comprises:

a reporting and billing manger to generate a report and/or bill to the sponsor pursuant to a predetermined set of reporting and billing rules and the transaction data (See paragraphs 77 & 161, which discusses status reports; and, how the system receives financial reports and verifies award compliance).

However, Corrie et al. does not expressly disclose:

an enterprise management system for managing a plurality of grants for a grantee received from a plurality of grant sponsors;

Kanefsky discloses managing numerous grants received from a plurality of grantors (See figure 1 and paragraph 21, which illustrates and discusses a grant

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management and reporting system incorporating a plurality of grants and grantors).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include automated management of multiple grants received by a recipient as taught by Kanefsky in order to report the results of grant activities to multiple grantors and to allow grantors to monitor the activities of grantees in real time (See paragraphs 7 & 9, which discusses reporting grant activities to various administrative agencies and allowing the grantor to monitor the activities of a grantee in real time).

As per claim 24, Corrie et al. teaches wherein the sponsor and grantee run the grant on different terms (See paragraphs 1-7, which discusses how federal grants management and different agencies have diverse procedures and requirements related to grants management).

Claim 25 recites equivalent limitations to claim 5 and is therefore rejected using the same art and rationale set forth above.

As per claim 26, Corrie et al. teaches wherein the grant management system further comprises:

an availability control unit to determine if the converted data would cause a limit defined under the grant to be exceeded (See paragraphs 155 & 164, which discusses how funds are obligated based on agreement accounting rules, and how a determination is dynamically made by the financial management system whether limits are exceeded); and

a database storing converted transaction of transaction requests that map to valid classifications that do not exceed the defined limits (See paragraph 44, which discusses how the grant management system includes permanent or removable storage on which the process and data structures can be stored and distributed).

However, Corrie et al. does not expressly disclose:

an interpretation logic unit to convert values of the transaction request from a domain of the transaction system to a domain defined for an identified grant; and

a dimensional control unit to determine if the converted data maps to a classification that has been defined under the grant to be valid.

Kanefsky discloses determining if received or imported grant or financial information falls within a specified grant (See paragraph 33, which discusses receiving/importing grant and financial information and establishing detailed records pertinent to a specific grant). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include converting received/imported grant and financial information to detailed records of a specified grant as taught by Kanefsky in order to provide data in a format that can be automatically uploaded (See paragraph 11, which discusses providing data in a format that can be automatically uploaded).

As per claim 27, Corrie et al. teaches an enterprise management system, comprising:

a transaction management system (See figure 1, which illustrates a financial management system), operating under a predetermined set of transaction rules and

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responsive to a transaction request by validating and accepting the transaction (See paragraphs 129 & 163, which discusses approving payment requests and accepting grant financial reports);

a grants management system provided in communication with the transaction system (See figure 1, which illustrates a grants management system operatively connected with a financial management system) and comprising:

an availability control unit to determine, based on the predetermined set of transaction rules, if the converted data would cause a limit defined under the grant to be exceeded (See paragraphs 155 & 164, which discusses how funds are obligated based on agreement accounting rules, and how a determination is dynamically made by the financial management system whether limits are exceeded); and

a database storing converted transaction of the transaction requests that map to valid classifications that do not exceed the defined limits (See paragraph 44, which discusses how the grant management system includes permanent or removable storage on which the process and data structures can be stored and distributed); and

a reporting and billing manager to submit a report and/or a bill according to a predetermined set of rules (See paragraphs 77 & 161, which discusses status reports; and, how the system receives financial reports and verifies award compliance).

However, Corrie et al. does not expressly disclose:

an enterprise management system for managing grants for a grantee received from grant sponsors;

an interpretation logic unit to covert values of the transaction request from a domain of the transaction system to a domain defined for an identified grant; and a dimensional control unit to determine if the converted data maps to a classification that has been defined under the grant to be valid.

Kanefsky discloses managing numerous grants received from a plurality of grantors (See figure 1 and paragraph 21, which illustrates and discusses a grant management and reporting system incorporating a plurality of grants and grantors) and determining if received or imported grant or financial information falls within a specified grant (See paragraph 33, which discusses receiving/importing grant and financial information and establishing detailed records pertinent to a specific grant). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include converting received/imported grant and financial information to detailed records of a specified grant and incorporating automated management of multiple grants received by a recipient as taught by Kanefsky in order to provide data in a format that can be automatically uploaded, report the results of grant activities to multiple grantors, and to allow grantors to monitor the activities of grantees in real time (See paragraphs 7, 9, & 11, which discusses reporting grant activities to various administrative agencies, allowing the grantor to monitor the activities of a grantee in real time, and providing data in a format that can be automatically uploaded).

3. **Claims 11, 19, & 21** are rejected under 35 U.S.C. 103(a) as being unpatentable over Corrie et al. (U.S. 2002/0120538), in view of Kanefsky (U.S. 2005/0192826), and further in view of Official Notice.

As per claim 11, Corrie et al. teaches a first database (See paragraph 44, which discusses how the grant management system includes permanent or removable storage on which the process and data structures can be stored and distributed).

However, the Corrie et al. and Kanefsky combination does not disclose first and second databases, one provided for the transaction system and the other provided for the grants management system, each storing transaction data of transactions admitted by the grants management system, the transaction system's database storing the original transaction data and the other grants management database storing the converted transaction data.

The Examiner takes Official Notice that it is old and well known in the art to include multiple databases in systems that are operatively connected. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Corrie et al. and Kanefsky combination to include a first and second database for storing transaction data and converted transaction data in order to combine the known features of multiple operative systems and databases to achieve the predictable result of having more than one database for transaction data.

As per claim 19, the Corrie et al. and Kanefsky combination does not disclose wherein the administrative and financial requirements from one sponsor is different from the administrative and financial requirements from another sponsor.

The Examiner takes Official Notice that it is old and well known in the art to have different financial and administrative requirements for various grants (i.e. different requirements for financial aid loans as opposed to housing lotteries). Therefore, it

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would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Corrie et al. and Kanefsky combination to include different financial and administrative requirements for various grants in order to combine the known features of grants and lending criteria to achieve the predictable result of assuring that a grantor's requests are satisfied.

As per claim 21, the Corrie et al. and Kanefsky combination does not disclose wherein the report and the bill are generated according to the sponsor's currency, dimension, and fiscal year.

The Examiner takes Official Notice that it is old and well known in the art to generate reports or bills according to pre-determined criteria. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Corrie et al. and Kanefsky combination to include generating reports and bills according to a sponsor's request in order to combine the known features of reporting/billing and lending criteria to achieve the predictable result of providing lender's with documentation of bill/reports (i.e. billing/reporting at the end of every fiscal year).

4. **Claim 12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Corrie et al. (U.S. 2002/0120538), in view of Kanefsky (U.S. 2005/0192826), and further in view of Chen (U.S. 7,111,010).

As per claim 12, Corrie et al. teaches wherein the grants management system comprises a database (See paragraph 44, which discusses how the grant management

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system includes permanent or removable storage on which the process and data structures can be stored and distributed).

However, the Corrie et al. and Kanefsky combination does not disclose wherein the grants management system comprises a database storing a data cube of aggregated transaction data, the data cube having dimensions of all parameters defined for all grants managed by the grants managements system.

Chen (U.S. 7,111,010) discloses techniques for managing information necessary for providing business support (See abstract).

Corrie et al., Kanefsky, and Chen disclose methods of managing business information. Chen discloses the use of data cubes with various dimensions used to store information (See column 3, lines 20-45, which discusses how cube data and structure are used to store information). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Corrie et al. and Kanefsky combination to include a data cube with various dimensions containing aggregated transaction data as taught be Chen in order to use multidimensional models, statistical computations, rule based systems, report generators and the like to enable a decision maker to understand, analyze and present relationships among various information entities (See column 4, lines 27-41).

(10) Response to Argument

A. M.P.E.P and Legal Precedent

The legal concept of prima facie obviousness is a procedural tool of examination which applies broadly to all arts. It allocates who has the burden of going forward with production of evidence in each step of the examination process. See *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976); *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972); *In re Saunders*, 444 F.2d 599, 170 USPQ 213 (CCPA 1971); *In re Tiffin*, 443 F.2d 394, 170 USPQ 88 (CCPA 1971), amended, 448 F.2d 791, 171 USPQ 294 (CCPA 1971); *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the Examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness. If, however, the Examiner does produce a prima facie case, the burden of coming forward with evidence or arguments shifts to the Applicant who may submit additional evidence of nonobviousness, such as comparative test data showing that the claimed invention possesses improved properties not expected by the prior art. The initial evaluation of prima facie obviousness thus relieves both the Examiner and Applicant from evaluating evidence beyond the prior art and the evidence in the specification as filed until the art has been shown to *>render obvious< the claimed invention.

To reach a proper determination under 35 U.S.C. 103, the Examiner must step backward in time and into the shoes worn by the hypothetical “person of ordinary skill in

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the art” when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention “as a whole” would have been obvious at that time to that person.

During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification.” The Federal Circuit’s en banc decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005) expressly recognized that the USPTO employs the “broadest reasonable interpretation” standard: The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1).

The Examiner summarizes the various points raised by the Appellant and addresses them individually.

B. The Rejection of Claims 1-10, 13-18, 20, & 22-27 Under 35 U.S.C. 103(a) as Being Unpatentable Over Corrie et al., and Further in View of Kanefsky.

1. The Kanefsky Reference is a Proper Prior Art Reference

Appellant asserts that Kanefsky non-provisional (U.S. 2005/0192826) filed on August 29, 2004, is not a proper prior art reference because it does not benefit from the effective filing date of the Kanefsky provisional (U.S. 60/496826).

The Examiner respectfully disagrees with Appellant's assertion. First, in the Advisory Action entered October 14, 2008, the Examiner refers Appellant to MPEP 706, which states that if a reference properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application. This goes hand-in-hand with MPEP 2136.03 III, which states that the 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications and certain international application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application if the provisional application properly supports the subject matter relied upon to make the rejection in compliance with 35 U.S.C. 112, first paragraph. Accordingly, the disclosure of the prior-filed application, the Kanefsky provisional application, must provide adequate support and enablement for the claimed subject matter of the later-filed application, the Kanefsky non-provisional application, in compliance with the requirements of 35 U.S.C. 112, first paragraph.

In regards to 35 U.S.C. 112, first paragraph, MPEP 201.11 states that when claiming the benefit of provisional applications under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that

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claims the benefit of the provisional application. In *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional application to be afforded the priority date of the provisional application, “the specification of the provisional must contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,’ 35 U.S.C. § 112 ¶1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application.”

Second, Appellant is not arguing that the Kanefsky non-provisional application does not disclose, teach, or suggest the pending claims of the present invention, but rather his sole argument is that that Kanefsky provisional application does not provide 35 U.S.C. 112, first paragraph support for the subject matter relied upon in the Kanefsky non-provisional application. The Examiner maintains that a prima facie case of obviousness has been established and that Appellant has failed to shift the burden by coming forward with specific evidence or arguments. As stated in Advisory Action entered October 14, 2008, the Examiner notes that Appellant’s arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In the Appeal Brief on pages 9 & 10, Appellant makes sweeping allegations that the Kanefsky provisional application does not include any figures or corresponding text that matches the exact disclosure in Kanefsky non-provisional application. Although the Kanefsky provisional application may not contain the exact figures and terminology, it provides a full, clear, and concise

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description that would enable an ordinary skilled artisan to practice the invention claimed in the Kanefsky non-provisional application.

a) In regards to claim 1, Appellant alleges that the Kanefsky provisional application does not provide disclosure for figure 1 and paragraph 21 in the Kanefsky non-provisional application.

The Examiner respectfully disagrees with Appellant's assertion. The Examiner cites figure 1 and paragraph 21 to disclose, teach, and suggest a computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors or grantors. Figure 1 and paragraph 21 of the Kanefsky non-provisional application explicitly and implicitly discloses, teaches, and suggests a computerized grant management and reporting system that provides web-based, on-line services to a plurality of grantors and grantees. The discussion on pages 2 & 14 and the figures on pages 67-68 of the Kanefsky provisional application discloses, teaches, and suggests a computerized grant reporting system, otherwise known as GLOWS, that provides a web-based, on-line services that allows grantees to access the system based on grants offered by multiple grantors and, subsequently, eligible grants based on authorization. Additionally, page 14 discusses how grantees may not access grants awarded to other grantees. Therefore, the Kanefsky provisional application provides a full, clear, and concise description that would enable a skilled artisan to practice a grant system that is accessible by both grantors and grantees and allows grantees to manage respective grants accordingly.

The Examiner maintains that the cited portions of the Kanefsky non-provisional application are supported by the Kanefsky provisional application. Thus, based on a

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broad and reasonable claim construction, the Kanefsky provisional application provides 35 U.S.C. 112, first paragraph support for a computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors or grantors.

b) In Appellant's second example of claim 1, Appellant alleges that the Kanefsky provisional application does not provide disclosure for paragraph 33 in the Kanefsky non-provisional application. Additionally, Appellant alleges that paragraph 33 is merely a description of corresponding figure 4 and the Kanefsky provisional application does not contain a matching figure 4 or describe a system as illustrated in figure 4.

The Examiner respectfully disagrees with Appellant's assertions. The Examiner cites paragraph 33 to disclose, teach, and suggest determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid. Based on a broad and reasonable claim construction, the limitation in question simple converts imported data to previously defined files or folders for respective grants. Paragraph 33 of the Kanefsky non-provisional application explicitly and implicitly discloses, teaches, and suggests receiving/importing grant and financial information and establishing detailed records pertinent to a specific grant. The discussion on pages 3, 11, & 27 of the Kanefsky provisional application discloses, teaches, and suggests importing and exporting data into and from the grant reporting system, otherwise known as GLOWS. The GLOWS system can convert imported and exported data to files or folders already defined in the system. Therefore, the Kanefsky provisional application provides a full, clear, and concise description that would enable a skilled artisan to practice converting data to a domain, file, or folder for specified grants previously defined in the system.

The Examiner maintains that the cited portions of the Kanefsky non-provisional application are supported by the Kanefsky provisional application. Thus, based on a broad and reasonable claim construction, the Kanefsky provisional application provides 35 U.S.C. 112, first paragraph support for determining if the converted data maps to a classification that has been defined under the one of the plurality of grants to be valid.

The Examiner maintains that Appellant failed to rebut the prima facie case of obviousness established in the Final Rejection entered August 1, 2008, because Appellant failed to provide specific evidence or arguments as to how the Kanefsky provisional application would not enable a skilled artisan to practice the disclosures, teachings, and suggestions relied on from the Kanefsky non-provisional application. Thus, the Examiner has properly responded to all arguments provided by the Appellant. Independent claims 6, 10, 13, 20, 23, & 27 and dependent claims 2-5, 7-9, 14-18, 22, & 24-26 are not argued separately and therefore stand or fall with independent claim 1.

2. The Combination of Corrie et al. and Kanefsky Renders Claims 1-10, 13-18, 20, & 22-27 Unpatentable.

In regards to claim 1, Appellant alleges that the Examiner has failed to present a prima facie case of obviousness because the Kanefsky provisional application does not support the subject matter relied on from the Kanefsky non-provisional application.

The Examiner respectfully disagrees with Appellant's assertion. First, as set forth above, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In the Appeal Brief on pages 11 & 12, Appellant makes sweeping

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allegations that the Kanefsky provisional application does not include any figures or corresponding text that matches the exact disclosure in Kanefsky non-provisional application. Although the Kanefsky provisional application may not contain the exact figures and terminology, it provides a full, clear, and concise description that would enable an ordinary skilled artisan to practice the invention claimed in the Kanefsky non-provisional application.

Second, as outlined above, the Examiner provides a detailed explanation on how the Kanefsky provisional application supports a computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors relied on from the Kanefsky non-provisional application. Appellant does not set forth any additional arguments and continues to make sweeping allegations that the subject matter relied on in the Kanefsky non-provisional application lack 35 U.S.C. 112, first paragraph support in the Kanefsky provisional application. Based on a broad and reasonable claim construction, the Examiner maintains that the Kanefsky provisional application provides 35 U.S.C. 112, first paragraph support for a computer-implemented grants management method for managing a plurality of grants for a recipient received from a plurality of grant sponsors.

Third, Appellant alleges that the Kanefsky provisional application does not provide disclosure for paragraph 33 in the Kanesky non-provisional application.

The Examiner respectfully disagrees with Appellant's assertions. The Examiner cites paragraphs 33 to disclose, teach, and suggest, responsive to a transaction request and data associate therewith, converting values of the associated data from a domain of

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a transaction system to a domain defined for one of the plurality of grants. Based on a broad and reasonable claim construction, the limitation in question imports transaction data by converting the respective data from a transaction file or folder to a file or folder defined for a specified grant. Paragraph 33 of the Kanefsky non-provisional application explicitly and implicitly discloses, teaches, and suggests receiving/importing grant and financial information and establishing detailed records pertinent to a specific grant. The discussion on pages 3, 11, & 27 of the Kanefsky provisional application discloses, teaches, and suggests importing and exporting data into and from the grant reporting system, otherwise known as GLOWS. The GLOWS system can convert imported and exported data to files or folders already defined in the system. Therefore, the Kanefsky provisional application provides a full, clear, and concise description that would enable a skilled artisan to practice converting transaction data to a domain, file, or folder for specified grant previously defined in the system.

The Examiner maintains that the cited portions of the Kanefsky non-provisional application are supported by the Kanefsky provisional application. Thus, based on a broad and reasonable claim construction, the Kanefsky provisional application provides 35 U.S.C. 112, first paragraph support for responding to a transaction request by converting data from a transaction file or folder to a file or folder defined for a specified grant.

The Examiner maintains that Appellant failed to rebut the prima facie case of obviousness established in the Final Rejection entered August 1, 2008, because Appellant failed to provide specific evidence or arguments as to how the Kanefsky

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provisional application would not enable a skilled artisan to practice the disclosures, teachings, and suggestions relied on from the Kanefesky non-provisional application. Thus, the Examiner has properly responded to all arguments provided by the Appellant. Independent claims 6, 10, 13, 20, 23, & 27 and their dependent claims 2-5, 7-9, 14-18, 22, & 24-26 are not argued separately and therefore stand or fall with independent claim 1.

3. The Final Office Entered August 1, 2008, Considers Every Element in Claims 1-5

In regards to claim 1, Appellant alleges that the Examiner has failed to consider, responsive to a transaction request and data associated therewith, converting values of the associated data from domain of a transaction system to a domain defined for one of the plurality of grants.

The Examiner respectfully disagrees with Appellant's assertion. First, as set forth above, Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. In the Appeal Brief on pages 12 & 13, Appellant makes a broad, sweeping allegation that the Examiner failed to address a specific limitation. As outline above, the Examiner addressed the above-identified element. The Examiner provides a detailed explanation on how the Kanefesky provisional application supports the subject matter relied on from the Kanefsky non-provisional application. Based on a broad and reasonable claim construction, the Examiner maintains that the Kanefsky provisional application provides 35 U.S.C. 112, first paragraph support for responding to a

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transaction request by converting data from a transaction file or folder to a file or folder defined for a specified grant.

Second, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Based on the detailed explanation set forth above, the Kanefsky provisional application, and subsequent Kanefsky non-provisional application, would have suggested to one of ordinary skill in the art that any grant activity or transaction data associate therewith could be imported and converted into and within the grant management system. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Corrie et al. to include converting received/imported grant and financial information to detailed records of a specified grant as taught by Kanefsky in order to provide data in a format that can be automatically uploaded, report the results of grant activities to multiple grantors, and to allow grantors to monitor the activities of grantees in real time (See paragraphs 7, 9, & 11, which discusses reporting grant activities to various administrative agencies, allowing the grantor to monitor the activities of a grantee in real time, and providing data in a format that can be automatically uploaded).

The Examiner maintains that the Final Rejection entered August 1, 2008, establishes a prima face case of obviousness because the Examiner addressed every

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element in claims 1-5. Thus, the Examiner has properly responded to all arguments provided by the Appellant. Dependent claims 2-5 are not argued separately and therefore stand or fall with independent claim 1.

C. The Rejection of Claims 11, 19, & 21 Under 35 U.S.C. 103(a) as Being Unpatentable Over Corrie et al., in View of Kanefsky, and Further in View of Official Notice.

As set forth above, the Examiner has provided a detailed explanation concerning the alleged deficiencies of the combination of Corrie et al. and Kanefsky. Since dependent claims 11, 19, & 21 are not argued separately, they stand and fall with respect to independent claims 10, 13, & 20. The Examiner maintains that Appellant has failed to rebut the prima facie obviousness rejection of claims 11, 19, & 21.

D. The Rejection of Claim 12 Under 35 U.S.C. 103(a) as Being Unpatentable of Corrie et al., in View of Kanefsky, and Further in View of Chen.

As set forth above, the Examiner has provided a detailed explanation concerning the alleged deficiencies of the combination of Corrie et al. and Kanefsky. Since dependent claim 12 is not argued separately, it stands and falls with respect to independent claim 10. The Examiner maintains that Appellant has failed to rebut the prima facie obviousness rejection of claim 10.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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